

REMARKS

The Pending Claims

Claims 30-32 are canceled herein without prejudice. Applicant reserves the right to claim the subject matter of claims 30-32 in continuing applications. Claims 1-25 are currently pending. No claim is currently allowed.

I. Rejection under 35 U.S.C. § 103

Claims 1-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Laugharn *et al* (U.S. Patent No. 6,120,985; hereinafter “Laugharn”) in view of Smith *et al*. (U.S. Patent No. 6,310,199; hereinafter “Smith”). (Office Action, page 3.) Applicant respectfully disagrees.

Applicant respectfully submits that none of the cited combinations of references render the claimed invention *prima facie* obvious. The obviousness analysis under 35 U.S.C. § 103(a) requires the consideration of the scope and the content of the prior art, the level of skill in the relevant art, and the differences between the prior art and the claimed subject matter. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Applicants note that if a modification changes the principle of operation of a reference, then there cannot be said that a reasonable expectation of success exists.

Claim 1 recites, in part, “the solid supports having a surface capable of effecting a chromatographic interaction.” At page 17, lines 18-29 of the specification chromatographic interactions are described as “a solid phase which has surface chemistry which effects classical chromatography interactions such as ion exchange (including both anion exchange and cation exchange), reverse phase interactions or hydrophobic interactions.”

In contrast however, Laugharn discloses in the first paragraph of the Summary of the Invention (column 1 line 50-53) “[t]he invention is based on the discovery that hydrobaric, hydrostatic pressure reversibly alters the partitioning of biomolecules between certain adsorbed and solvated phases relative to partitioning at ambient pressure”. Thus, the presently claimed invention is directed in part to methods relating to ion exchange, reverse phase or hydrophobic interactions while the cited art is directed to hydrobaric/hydrostatic pressure and the partitioning of biomolecules. Given the differing modes of operation between the presently claimed invention

and the cited art, one skilled in the art would not have a reasonable expectation of success in applying the teachings of Laugharn.

In view of the above, none of the cited references, alone or in combination, teach or suggest the binding of target proteins to solid supports having a surface capable of effecting a chromatographic interaction wherein the solid supports to which nucleic acids components are bound are distinct from the solid supports to which protein components are bound, and wherein the solid support are in the form of magnetic particles as recited in independent claim 1.

Accordingly, Applicant requests that the rejections of claims 1 to 25 under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding objections and rejections are respectfully requested. All amendments are made in a good faith effort to advance the prosecution on the merits. Applicant respectfully submits that no amendments have been made to the pending claims for the purpose of overcoming any prior art rejections that would restrict the literal scope of the claims or equivalents thereof. Applicant reserves the right to subsequently take up prosecution of the claims originally filed in this application in continuation, continuation-in-part, and/or divisional applications.

The Examiner is encouraged to call the undersigned should any further action be required for allowance.

Respectfully submitted,

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